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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/529,847

06/13/2005

Jun Sakamoto

IPE-052

1538

20374 7590 08/11/2008

KUBOVCIK & KUBOVCIK

SUITE 1105

1215 SOUTH CLARK STREET

ARLINGTON, VA 22202

EXAMINER

MESH, GENNADIY

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,847	<b>Applicant(s)</b> SAKAMOTO ET AL.	
	<b>Examiner</b> GENNADIY MESH	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8 and 13 - 52 is/are pending in the application.
- 4a) Of the above claim(s) 20-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's Amendment filed on June 8, 2008 is acknowledged.

Rejection is maintained as it set forth in previous Office action mailed on April 8, 2008.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1,8 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.( US 6,365,659) in view of Naylor et al.( WO 97/47675) combine with Kato et al.( US 6,680,353).

The rejection is adequately set forth in paragraph 1 of the action mailed April 8,2008 and is incorporated here by reference.

2. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.( US 6,365,659) in view of Naylor et al.( WO 97/47675) combine with Kato et al.( US 6,680,353) as it applied to claims 1, 8 and 13-18 above, and in further view of Uchida et al.( US 6,670,030).

The rejection is adequately set forth in paragraph 2 of the action mailed April 8,2008 and is incorporated here by reference.

***Response to Arguments***

3. Applicant's arguments filed July 8, 2008 have been fully considered but they are not persuasive.

3.1. Applicant's arguments related to Claims 1, 8 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al. (US 6,365,659) in view of Naylor et al. (WO 97/47675) combined with Kato et al. (US 6,680,353) based on alleged deficiency of individual references and statement that rejection fails provide rationale supporting position that one of ordinary skill would combine cited references.

Both arguments were found unpersuasive for following reasons:

Aoyama as a Primary reference does not need disclosed all elements claimed by applicant.

Note, that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As it was shown in rejection, combination of Aoyama with Naylor and Kato teach all elements of subject matter claimed by Applicant (see rejection provided in previous office action mailed on April 8, 2008). Rationale for combine references also can be found in previous rejection and actually was cited by Applicant in this Arguments (see page 2 and 3 of Arguments).

In addition note, that in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can

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only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, as it was explained in rejection, it would have been obvious to ordinary skill in the art at the time of the invention to use **specific titanium catalyst per teaching of Naylor in order to obtain composition disclosed by Aoyama with better (low) haze and color (white hue).**

And because, Kato teaches that this specific compound as ethyl diethylphosphonoacetate is preferable in view of "the excellent effects of coloring prevention and melt stability" – it would have been obvious to ordinary skill in the art at **the time of the invention to use ethyl diethylphosphonoacetate in polyester resin composition in order to obtain polymer with good color and melt stability.**

Therefore, applicant's statement that one of ordinary skill would combine cited references is unpersuasive.

Applicant also argues that combination of Aoyama with Naylor and Kato fail to predict that use of this specific compound as ethyl diethylphosphonoacetate lead to unpredicted result of "effect of decreasing irregular particles" as it can be concluded from Examples 1, 5 and 6.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., effect of decreasing irregular particles) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition note, that Examples 1, 5 and 6 can not provide support for Applicant's statement (ethyl diethylphosphonoacetate lead to unpredicted result as "effect of decreasing irregular particles), because data for amount of particle for Example 5 is not provided, and data for Example 1 and 6 indicated no difference in amount of particles for two catalytic system, one ( Example 1) based ethyl diethylphosphonoacetate and another ( Example 6) based on trimethylphosphoric acid ( see [0339]).

Therefore, Applicant's arguments were found unpersuasive.

3.2. Applicant's arguments related to Claim 19 based on alleged deficiency rejection of Claims 1,8 and 13-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama et al.( US 6,365,659) in view of Naylor et al.( WO 97/47675) combine with Kato et al.( US 6,680,353). Because it was shown that Applicant's arguments regarding this rejection are not persuasive ( see paragraph 3.1.) than same applicable to Applicant's arguments related to Claim 19.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GENNADIY MESH whose telephone number is (571)272-2901. The examiner can normally be reached on 10 a.m - 6 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272 1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Gennadiy Mesh  
Examiner  
Art Unit 1796

/GM/

/VASUDEVAN S. JAGANNATHAN/  
Supervisory Patent Examiner, Art Unit 1796